



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,591	01/20/2006	Richard Merken-Schiller	HO-P03195US0	9719
26271 7590 10/24/2008 FULBRIGHT & JAWORSKI, LLP 1301 MCKINNEY SUITE 5100 HOUSTON, TX 77010-3095				
EXAMINER DURAND, PAUL R				
ART UNIT		PAPER NUMBER		
3721				
MAIL DATE		DELIVERY MODE		
10/24/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/540,591

Applicant(s)

MERKEN-SCHILLER ET AL.

Examiner

PAUL R. DURAND

Art Unit

3721

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 September 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1, 3-12 and 14-28.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/PAUL R. DURAND/
Primary Examiner, Art Unit 3721

Continuation of 11. does NOT place the application in condition for allowance because: The examiner does agree with applicant that the neither the level of ordinary skill in the art nor secondary considerations are applicable to the present case. Applicant has not submitted any objective evidence which would be applicable to a secondary consideration of non-obviousness. Moreover, the examiner asserts that the present invention and cited prior art adequately reflects the level of ordinary skill in the art as all are generally concerned with pressure molding of packages. See generally MPEP §§ 2141, 2141.03.

Applicant's assertion that the combined references of Patterson and Ellison do not teach the arrangement of creases along the entire lower edge portion of the mold is not correct. First, the examiner cannot find support in the specification for this limitation as neither the specification, nor the drawings explicitly disclose this limitation. Moreover, the term "lower edge portion" introduces a level of ambiguity into the claim. Is the lower edge a bottom portion of the mold or is a lip portion arranged around the edge of a mold? Additionally, it is unclear from the claim which mold is actually being claimed.

In Patterson, which is being relied on for this pertinent limitation, the blank is initially scored prior to insertion into the mold. As the tray is formed, the scored portions form creased portions around the walls of the tray. Alternatively, in view of the ambiguity of relevant limitation, a lateral fold can also encompass the lip of the tray, which is creased around the tray or the sidewalls of the individual compartments.

Additionally and in regard to the process claims, the wherein clause of the claims, followed by the pertinent recitation is not a positive limitation, but rather discloses the intended result of the process step positively recited above. See MPEP § 2111.04. In the apparatus claims, this clause is a functional recitation of the intended use of the apparatus and cannot serve as the basis of for patentability as the apparatus must be distinguished in terms of structure rather than structure. See MPEP § 2114.

Applicant further argues that the combination of Patterson and Ellison do not disclose controlling and reducing the tension of the film, while allowing film material to penetrate between the positive and negative film molds. The examiner does not agree with this argument.

Although the primary reference of Patterson does not disclose the adjustability of the clamping means, the examiner has relied on the teaching of Ellison to show applicant that it is old and well known to provide this limitation on a molding machine to prevent thinning and even breakage of the material during a formation process. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). As the combined references disclose this limitation the rejection is proper.

Applicant lastly argues that the dependant claims are allowable as the independent claims are allowable. This argument is not persuasive as the examiner has maintained the rejection of the independent claims. .